

R-2000-60

UNITED STATES PATENT AND TRADEMARK OFFICE MAY 12 2000
BEFORE THE DIRECTOR
OF THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re

)
)
) Decision on
) Petition for Regrade
) Under 37 C.F.R. § 10.7(c)
)

MEMORANDUM AND ORDER

(petitioner) petitions for regrading his answers to questions 4, 8, and 44 of the morning section and questions 5, 19, 21, 24, 44, 46, and 49 of the afternoon section of the Registration Examination held on November 3, 1999. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

BACKGROUND

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 63. On February 14, 1999, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, all regrade requests have been considered in the first instance by the Director of the USPTO.

OPINION

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: "No points will be awarded for incorrect

answers or unanswered questions.” The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the *Official Gazette*. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is “All of the above,” the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement *true*. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms “USPTO,” “PTO,” or “Office” are used in this examination, they mean the U.S. Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers.

All of petitioner’s arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded points for afternoon questions 11, 19, and 29. Accordingly, petitioner has been granted additional three points on the Examination. However, no credit has been awarded for morning questions 4, 6, and 44 and afternoon questions 5, 21, 24, 44, 46, and 49. Petitioner’s arguments for these questions are addressed individually below.

Morning question 4 reads as follows:

4. Beverly is a research chemist. While cleaning a clogged shower drain she recovers several ounces of goop from the drain. She analyzes the ingredients and properties, and finds that the goop makes a highly effective industrial lubricant. She comes to you for help in preparing and filing an application. She informs you that the goop is formed from equal parts of chemicals W, X, Y and Z. She knows that chemical W comes from the soap she uses and that chemicals Y and Z are components of the conditioner she uses on her hair. Her soap uses the tradename "Acme SmellNice", and her shampoo and conditioner both use the tradename "A-1 Silky." Chemicals W, Y and Z are all readily available on the commercial market. Chemical X is also a common, readily available chemical, but she cannot determine how it got in the shower drain. She suspects it is the result of a reaction between A-1 Silky shampoo and Acme SmellNice soap that occurs when the two are mixed in the presence of hot water. You prepare an application describing a prophetic example setting forth one way to make the goop from commercially available chemicals and a working example describing (as well as the inventor can) how the goop is formed in the bathroom drain. The working example describes mixing of A-1 Silky shampoo and Acme SmellNice soap in the presence of water having a temperature of at least 100°F to form chemical X. Because you know that the ingredients for at least Acme SmellNice soap have recently changed, but the nature of the change is unknown, you list every ingredient of A-1 Silky shampoo, and Acme SmellNice soap in positive language so there will be no confusion as to what is meant. The application includes the following claims:

- Claim 1. An industrial lubricant consisting essentially of equal parts of chemical W, chemical X, chemical Y and chemical Z.
- Claim 2. The industrial lubricant of Claim 1, wherein said chemical X is formed by mixing A-1 Silky shampoo and Acme SmellNice soap in the presence of water having a temperature of at least 100°F.

Which of the following statements is/are correct?

- (A) Claim 1 cannot be supported by an enabling specification because Beverly does not fully understand the processes that occurred in the drain, and a prophetic example alone is never sufficient to enable a claim.
- (B) Claim 2 is not patentable because it sets forth an incorrect theory of formation of chemical X.
- (C) Claim 1 is not patentable because Beverly merely found the goop in her drain and did not formulate it herself.
- (D) Claim 2 is not patentable because it is indefinite.
- (E) (B) and (D).

The model answer is choice (E).

Petitioner argues that none of the answers is correct. Petitioner contends that the use of trademarks in claim 2 does not render the claim indefinite because the ingredients of A-1 Silky shampoo and Acme SmellNice soap are listed in the specification. Petitioner concludes that answer (D) is incorrect and maintains that answers (B) and (E) are incorrect for the same reason.

Petitioner's argument has been fully considered but they are not persuasive. Contrary to petitioner's statement that "A-1 Silky" and "Acme SmellNice" are trademarks, the question specifically states that they are **tradenames**. As explained in MPEP 608.01(v), names used in trade are permissible in patent applications if: (A) their meanings are established by an accompanying **definition** which is sufficiently precise and definite to be **made a part of a claim**, or (B) in this country, their meanings are well-known and satisfactorily defined in the literature. Here, the definitions of A-1 Silky shampoo and Acme SmellNice soap are not made a part of claim 2 and their meanings are not well-known and defined because the ingredients have recently changed. Accordingly, neither condition (A) nor condition (B) set forth in MPEP 608.01 is met in claim 2, rendering the claim indefinite. The statement in answer (D) is correct.

The statement in answer (B) is correct because when an incorrect theory of operation is incorporated into a claim, that claim is invalid under either 35 U.S.C. § 101 (utility) or 35 U.S.C. § 112 (enablement). See *Raytheon Co. v. Roper Corp.*, 724 F2d 951, 220 USPQ 592, 596 (Fed. Cir. 1983). Since both statements in answers (B) and (D) are correct, answer (E) is the most correct choice. No error in grading has been shown. Petitioner's request for credit on is question is denied.

Morning question 8 reads as follows:

8. In which of the following situations, considered independently of each other, is the original, new, or amended claim supported in the application as filed?

- (A) An amendment to the specification changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong” and no amendment is made of the claim, which uses the term “holder.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (B) An amendment to the specification and claims changing the definition of “holder” from “is a hook” to “is a hook, clasp, crimp, or tong.” The amendment is filed one month after the application was filed. There was no previous supporting disclosure in the specification of the holder being a clasp, crimp, or tong.
- (C) Original claim 1 in the application refers to “a holder,” and original claim 2 depends from and refers to claim 1 stating, “said holder is a hook, clasp, crimp, or tong.” There is no disclosure in the specification preceding the claims in the application as filed for the holder to be a clasp, crimp, or tong.
- (D) An amendment is filed presenting a claim to an electrical insulating device, copied from a patent for the purpose of provoking an interference. The claim refers to “nonconductive plastic holder.” The application as filed contains a broad generic disclosure describing electrical insulating devices. The holder is described in the specification of the application as “conducting electricity.” There is no disclosure in the specification of the holder being “nonconductive.”
- (E) All of the above.

The model answer is choice (C). An originally-filed claim can provide its own written description. See MPEP 608.01(I).

Petitioner argues that answer (A) is also correct. Petitioner contends that the original specification has support for the claim in answer (A) because the claim recited the term “holder” and the original specification defined “holder” as a hook.

Petitioner’s arguments have been fully considered but they are not persuasive. As explained in MPEP 2163.03, “[a]n amendment to the specification (e.g., a change in the definition of a term used both in the specification and claim) may indirectly affect a claim even though no actual amendment is made to the claim.” In answer (A), the amendment to the

specification changes the definition of the term “holder” which is used both in the specification and in the claim. Even though no actual amendment is made to the claim in (A), nevertheless, the amendment indirectly affects the claim, i.e., changing the definition of the term “holder” used in the claim from “a hook” to “a hook, clasp, crimp, or tong.” Hence, the application as filed does not provide support for the term “holder” with the definition of “a hook, clasp, crimp, or tong.” Accordingly, (A) cannot be the correct answer for the question. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 44 reads as follows:

44. A practitioner should consider whether information presented during prosecution of an application may be used by the examiner as evidence against the applicant. What evidence may an examiner not use to demonstrate that a claim fails to correspond in scope with that which an applicant regards as his or her invention?

- (A) Arguments, containing admissions, advanced in a reply filed by the practitioner representing the applicant.
- (B) Admissions contained in a brief.
- (C) The lack of agreement between the claims and the specification.
- (D) Affidavits, containing admissions, filed under 37 CFR § 1.132.
- (E) All of the above.

The model answer is choice (C).

Petitioner argues that answer (C) is not correct. Petitioner contends that the type of evidence in (C) is not submitted by the practitioner, and if this type of evidence was submitted by a practitioner, it would constitute an argument containing an admission. Petitioner also argues that the term “lack of agreement” is a broad term, which includes agreements and/or lack of agreements as to scope. According to the petitioner, “an admitted lack of agreement written in the specification between the claims and the specification would be evidence that an Examiner

could use to demonstrate that a claim fails to correspond in scope with that which an applicant regards as his or her invention.”

Petitioner’s arguments have been fully considered but they are not persuasive. It is irrelevant whether the evidence is submitted by the practitioner or not. This type of evidence does not have to be presented by the practitioner in an argument. Furthermore, the question never states that the evidence is presented by the practitioner. Contrary to the petitioner’s contention, the evidence in (C) does not constitute an admission.

Under 35 U.S.C. 112, second paragraph, claims must set forth the subject matter that applicants regard as their invention. Also see MPEP 2171. As explained in MPEP 2172, “[t]he content of the applicant’s specification may not be used as evidence that the scope of the claims is inconsistent with the subject matter that applicant regards as his invention. As noted in *In re Ehrreich*, 590 F.2d 902, 200 USPQ 504 (CCPA 1979), the lack of agreement between the claims and specification is properly considered only with respect to 35 U.S.C. § 112, first paragraph.” (Emphasis added.) Accordingly, answer (C) is correct. No error in grading has been shown. Petitioner’s request for credit on this question 44 is denied.

Afternoon question 5 reads as follows:

5. On March 1, 1995, applicant filed a nonprovisional patent application for a stool. The original disclosure set forth that a base member of the stool was generally elliptical and, in particular, could be circular (a special kind of ellipse). It also stated that all leg members must be parallel to each other. The only claim included in the application stated as follows:

1. A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom.

In a first Office action rejection, the examiner rejected claim 1 under 35 U.S.C. § 102(e) as unpatentable over a U.S. Patent to Pigeon. The Pigeon patent specified that each of the leg members formed a thirty degree angle with each of the other leg members. Applicant filed a timely response to the Office action, amending the specification to state that the leg members could be substantially parallel and including guidelines for determining what would be considered “substantially parallel.” Applicant also amended claim 1 as follows:

1. (once amended) A stool for sitting on, comprising a circular shaped base member having a top surface and a bottom surface; said bottom surface having a center portion and three circular holes equally spaced about said center portion; and three leg members connected to said bottom surface, each hole having a leg member protruding therefrom, wherein the leg members are parallel to each other.

The examiner allowed Claim 1 as amended and a patent was granted to applicant on January 5, 1997. On January 5, 1999, applicant filed a reissue application, including a proper declaration pursuant to 37 CFR § 1.175. Assume that there is no other relevant prior art. In accordance with PTO rules and procedure, which of the following statements concerning the reissue application is true?

- (A) Any amendment to claim 1 so as to broaden its scope will likely be considered untimely.
- (B) If applicant amends claim 1 to replace “a circular shaped member” with “an elliptical shaped member,” then the amendment should be considered untimely since the amendment would broaden the scope of the claim.
- (C) If applicant amends claim 1 to delete “wherein the leg members are parallel to each other,” then the amended claim should be allowed.
- (D) If applicant amends claim 1 to replace “parallel” with “substantially parallel,” then the amended claim will likely be allowed.
- (E) None of the above.

The model answer is choice (E).

Petitioner argues that answer (E) is not correct. According to the petitioner, answers (A) and (B) could be correct because if the amendment is filed after January 6, 1999 and no amendment to broaden the scope of the claim is filed at the time of filing the reissue, then the amendment to broaden the scope of claim 1 would be untimely. Petitioner also alleges that

answer (D) is correct because the term “substantially parallel” may have been defined the same as the term “parallel.”

Petitioner’s arguments have been fully considered but they are not persuasive. The question states that a proper declaration pursuant to 37 CFR § 1.175 was filed with the reissue application within two years from the grant of the original patent. Under 37 CFR § 1.175, the reissue oath or declaration must also state at least one error being relied upon as the basis for the reissue. For example, “The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of the patentee claiming less than the patentee had the right to claim in the patent.” Since only one error (broadening claim 1) is presented in the question and in answer (A), the properly filed declaration must have include this error. Accordingly, any amendment to claim 1 so as to broaden it scope will be considered timely because the declaration was properly filed under § 1.175 with the intent of broadening the claim. Thus, answer (A) cannot be correct.

For the same reason, answer (B) cannot be correct because a proper declaration pursuant to 37 CFR § 1.175 was filed within two years from the grant of the original patent. The error of replacing “a circular shaped member” with “an elliptical shaped member” must have been identified in the declaration.

Petitioner’s argument for answer (D) is based on facts not presented in the question, specifically, “the term ‘substantially parallel’ may have been defined the same as the term ‘parallel.’” The scope of the term “substantially parallel” is broader than “parallel” because it covers deviations from parallel. The guidelines for determining what would be considered “substantially parallel” included in the specification does not avoid new matter issues. The

amendment that added the subject matter “substantially parallel” introduced new matter. As explained in MPEP 1411.02, the claims in the reissue application must be for subject matter which the applicant had the right to claim in the original patent. Here, the applicant does not have the right to claim the subject matter “substantially parallel” because the claim improperly relies on new matter. Thus, answer (D) is correct. Since the statements in answers (A) through (D) are true, therefore answer (E) is the most correct choice. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 21 reads as follows:

21. Which of the following files is ordinarily **not open** to the public?

- (A) A substitute application.
- (B) An interference proceeding file involving a U.S. patent.
- (C) A reissue application.
- (D) A reexamination proceeding file.
- (E) All of the above

The model answer is choice (A).

Petitioner argues that both answers (A) and (B) should be acceptable. Petitioner contends that an interference proceeding file involving a U.S. patent is not open to the public because petitioner assumes the proceeding is still in progress.

Petitioner’s arguments have been fully considered but they are not persuasive. Answer (B) cannot be accepted because it is not the most correct answer. Petitioner’s arguments are based on facts not present in the question, specifically, the interference proceeding is still in progress. Under 37 CFR 1.11(e), an interference proceeding file involving a U.S. patent is **open to inspection by the public**, and copies may be obtained upon paying a fee thereof if the

interference has terminated or an award of priority or judgment has been entered as to all parties and all counts. Thus, an interference file is ordinarily open to the public. Answer (A) is a better choice than answer (B) because a substitute application is ordinarily not open to the public. See MPEP 103 and 201.09. Accordingly, answer (A) is the most correct answer. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 24 reads as follows:

24. Claims 1 through 5 in a patent application read as follows:

1. A computer comprising:
 - (i) a microprocessor having a maximum clock rate of 350 megahertz;
 - (ii) a random access memory chip coupled to said microprocessor;
 - (iii) a read only memory chip coupled to said microprocessor; and
 - (iv) a case enclosing said microprocessor, said random access memory chip, and said read only memory chip.
2. The computer of claim 1, wherein said case has an outer surface comprised of plastic.
3. The computer of claims 1 or 2, further comprising a peripheral controller chip coupled to said microprocessor.
4. The computer of claim 1, wherein said memory chip has eight million storage locations.
5. The computer of claim 2, wherein said microprocessor has a maximum clock rate of 400 megahertz.

Which of the following is/are proper dependent claims(s) in accordance with 37 CFR §1.75?

- (A) Claims 2 and 3.
- (B) Claim 4 only.
- (C) Claims 2 and 5.
- (D) Claim 2 only.
- (E) None of the above

The model answer is choice (A).

Petitioner argues that none of the answers is correct. Petitioner alleges that claim 3 is not a proper dependent claim because none of the examples in the MPEP 608.01(n) use the phase "of

claims 1 or 2 ” without first using the phrase “as in one and/or any one.” Petitioner further argues that claim 5 is a proper dependent claim because claim 5 refers back to a proper dependent claim.

Petitioner’s arguments have been fully considered but they are not persuasive. In response to the petitioner’s argument, claim 3 is a proper multiple dependent claim. As explained in MPEP 608.01(n), a multiple dependent claim is a dependent claim which refers back **in the alternative** to more than one preceding independent or dependent claim. The MPEP lists some of the examples to provide samples of acceptable claim languages that are in alternative form. The examples do not set forth mandatory claim language for multiple dependent claims. Here, the phase, “the computer of claims **1 or 2**,” in claim 3 is referring back in the alternative to more than one preceding claims, meeting the requirements set forth in MPEP 608.01(n). Accordingly, claims 2 and 3 are proper dependent claims. Answer (A) is the most correct choice.

Contrary to the petitioner’s conclusion, claim 5 cannot be a proper dependent claim just because it refers back to a proper dependent claim. Under 35 USC 112, fourth paragraph, a dependent claim must further limits the subject matter claimed in the previous claim. In order for claim 5 to be a proper dependent claim, it must further limits the subject matter sets forth in claim 2, which incorporates all the limitations of claim 1. However, the limitation in claim 5, “a maximum clock rate of 400 megahertz,” is outside the range limitation, “a maximum clock rate of 350 megahertz,” provided in claim 1. Thus, claim 5 is not further limiting. Answer (C) cannot be correct. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 44 reads as follows:

44. G is the sole inventor in a patent application filed in the PTO describing and claiming a surgical instrument. H is the sole inventor in a patent application filed in the PTO describing G's surgical instrument, as well as describing and claiming a modified embodiment of G's surgical instrument. Following proper PTO practices and procedures, under which circumstance is it most likely that you will need to overcome a provisional 35 U.S.C. § 102(e)/103 rejection in G's application?

- (A) G's application is filed in the PTO before H's application, and they do not have a common assignee.
- (B) H's application is filed in the PTO before G's application, and they do not have a common assignee.
- (C) G's application is filed in the PTO on the same date as H's application, and they have a common assignee.
- (D) G's application is filed in the PTO after H's application, and they have a common assignee.
- (E) G's application is filed in the PTO before H's application, and they have a common assignee

The model answer is choice (D).

Petitioner argues that answers (A), (B) and (E) are correct. Petitioner alleges that "a wrongful rejection cited by the examiner is the 'most sure' way to overcome a rejection."

Petitioner further contends that since there is no common assignee in answers (A) and (B) and since G's application was filed prior to H's application in answer (E), the 102(e)/103 rejections would be improper in these situations.

Petitioner's arguments have been fully considered but they are not persuasive. Petitioner interprets the question incorrectly. The question asks "[f]ollowing proper PTO practices and procedures, under which circumstance is it most likely that you will need to overcome a provisional 35 U.S.C. § 102(e)/103 rejection in G's application?" The question did not ask the

“most sure” way to overcome a rejection, but instead asks about circumstances which would give rise to a 102(e)/103 rejection.

A provisional 102(e)/103 rejection in G’s application is most likely in the situation described in answer (D) because G’s application is filed after H’s application and they have a common assignee. See MPEP 706.02(k). Hence, answer (D) is correct.

Contrary to petitioner’s argument, answers (A), (B), and (E) cannot be correct because situations described in answers (A), (B) and (E) would not provide a proper provisional 102(e)/103 rejection in G’s application. In answers (A) and (B), there is no common assignee and in answer (E), G’s application is filed prior to H’s application. Therefore, one would not need to overcome a provisional 102(e)/103 rejection in G’s application in circumstances described in answers (A), (B) and (E). Accordingly, answer (D) is the most correct choice. No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Afternoon question 46 reads as follows:

46. On June 22, 1999, you receive a final Office action, dated June 17, 1999, rejecting numerous claims in a patent application that you filed in the PTO. The Office action did not set a shortened statutory period for reply. Following proper PTO practices and procedures, under which circumstances is it most likely your submission of new evidence under 37 CFR § 1.129(a) in support of patentability, along with the appropriate fee, will result in the automatic withdrawal of the finality of the final rejection?

- (A) The application is filed on June 8, 1995, it has an effective filing date of June 8, 1993, and you file the submission on October 14, 1999, one month after you file a Notice of Appeal to the Board of Patent Appeals and Interferences.
- (B) The application is filed on June 7, 1995, it has an effective filing date of June 8, 1993, and you file the submission on October 14, 1999, one month after you file an appeal brief to the Board of Patent Appeals and Interferences.
- (C) The application is filed on June 8, 1995, it has an effective filing date of June 7, 1993, and you file the submission on December 20, 1999.

- (D) The application is filed on June 7, 1995, it has an effective filing date of June 7, 1993, and you file the submission on the same day you file an appeal brief to the Board of Patent Appeals and Interferences.
- (E) (A) and (C).

The model answer is choice (A).

Petitioner argues that answer (D) is correct. According to the petitioner, answer (A) does not meet the requirement of 37 CFR 1.129 because the brief is filed with the Notice of Appeal. Petitioner further contends that the circumstance in answer (D) meets the requirement of 37 CFR 1.129 because petitioner assumes that the submission is filed in the morning and the appeal brief is filed in the afternoon.

Petitioner's arguments have been fully considered but they are not persuasive. Under 37 CFR 1.129, a timely submission should be filed prior to the filing of an appeal brief. An appeal brief may be filed 2 months from the date of the Notice of Appeal under 37 CFR 1.192(a) and the 2 month period may be extended 5 additional months under 37 CFR 1.136(a). Since an applicant has 7 months to file an appeal brief from the date of filing the Notice of Appeal, it would be unreasonable to assume that the appeal brief is filed with the Notice of Appeal in answer (A). Furthermore, petitioner's arguments are based on facts (the appeal brief is filed with the Notice of Appeal) not present in answer (A), which is a violation of the Examination directions.

The Office keeps track of the date of receipt for the filing of correspondences, however the Office does not keep track of the exact time when the correspondence is received. See 37 CFR 1.6. The situation described in answer (D) would not meet the 37 CFR 1.129 requirement that the submission must be filed prior to the filing of the appeal brief. Furthermore, petitioner's assumption of facts (the submission is filed in the morning and the appeal brief is filed in the afternoon) not present in answer (D) is also a violation of the Examination directions.

Therefore, answer (D) cannot be correct and answer (A) is the most correct choice. No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 49 reads as follows:

49. In preparing an application claiming only apparatus to be filed in the PTO, you inadvertently forgot to include a figure in the drawings. While, you did include a brief description of the figure in the written description of the invention in the specification nevertheless the invention of Claim 10 cannot be understood without the omitted figure in the drawings. Only after the application had been filed in the PTO did you realize that the figure was omitted. The application as filed included a proper declaration under 37 CFR § 1.63 signed by the inventor. What document(s), if any, must be filed in the PTO to obtain the original filing date in accordance with proper PTO practice and procedure?

- (A) An amendment deleting the description of the figure and Claim 10, and a petition with the proper fee to have the application accepted without the omitted figure.
- (B) An amendment filed before the first Office action deleting all references to the omitted figure and Claim 10 to have the application accepted without the omitted figure.
- (C) A petition and an amendment to add the figure to the application as soon as possible, and a supplemental declaration stating the omitted figure accurately illustrates and is part of the applicant's invention.
- (D) The omitted figure along with a supplemental oath or declaration stating that the omitted figure accurately illustrates and is part of the applicant's invention.
- (E) An amendment adding the figure to the application

The model answer is choice (B).

Petitioner argues that there is no correct answer to the question. Petitioner alleges that the applicant has already received an original filing date and therefore he does not need to do anything to obtain the original filing date. Petitioner also contends that the requirement of canceling all references to the omitted drawing is not necessary to retain the filing date, but only to avoid delays in prosecution.

Petitioner's arguments have been fully considered but they are not persuasive. Answers (C), (D), and (E) are incorrect because when the omitted figure is added to the application, the

applicant accepts the date of submission of the drawing as the filing date. See MPEP 601.01(g). The original filing date would not be retained in these situations. Answer (A) is also not the most correct choice because a petition with the proper fee is not required to have the application accepted without the omitted figure.

Canceling all references to the omitted drawing is required to retain the original filing date. See MPEP 601.01(g) and 608.02. The MPEP suggests that the applicant should meet this requirement prior to the first action because a delay in meet the requirement would cause delays in the prosecution. The best choice is answer (B) because the original filing date would be retained and the requirement set forth in MPEP 608.02 is met. No error in grading has been shown. Petitioner's request for credit on this question is denied.

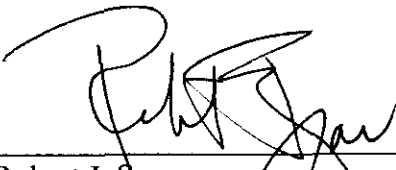
No error in grading has been shown as to morning questions 4, 6, and 44 and afternoon questions 5, 21, 24, 44, 46, and 49. Petitioner's request for credit on these questions is denied.

ORDER

For the reasons given above, three points have been added to petitioner's score on the Examination. Therefore, petitioner's score is adjusted to 66. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.



Robert J. Spar
Director, Office of Patent Legal Administration
Office of the Deputy Commissioner
for Patent Examination Policy